

DETAILED ACTION

Response to Board Decision

In view of the Board of Patent Appeal's decision mailed on January 4, 2008, PROSECUTION IS HEREBY REOPENED on Application 09/981,877. **A NEW GROUNDS OF REJECTION** is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Donald Sparks/

Acting Director of TC 2100

Status of Claims Following decision:

Claims 4-8 and 12-16 – affirmed

Claims 1-3 and 9-11 – reversed

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 4-8 and 12-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Microsoft, "Microsoft Word," hereinafter MSword.

3. With regard to claim 4, which teaches a method of displaying a clipboard comprising: receiving a paste command, MSword teaches, in figure 2 and 4, receiving a paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad. With regard to claim 4, which further teaches determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first, and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen. With regard to claim 4, further teaching displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than one item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items.

4. With regard to claims 5 and 13, which teach displaying a clipboard adjacent the display position indicator comprises positioning an icon associated with a last pasted

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object adjacent the display position indicator, MSword teaches, in figures 1 and 2, displaying the clipboard adjacent to the pointer where the last pasted object is located at the end of the list.

5. With regard to claims 6 and 14, which teach hiding the clipboard in response to selecting an icon corresponding to an image on a clipboard, MSword teaches, in figures 6 and 7, hiding the clipboard items, upon selection of an item, from a docked clipboard, to be pasted.

6. With regard to claims 7 and 15, which teach hiding the clipboard in response to moving the position indicator so that the position indicator is not adjacent to the clipboard, MSword teaches, in figures 6 and 7, hiding the clipboard upon position the indicator off of the clipboard and onto the document.

7. With regard to claims 8 and 16, which teach hiding the clipboard in response to selecting a close icon on the clipboard, MSword teaches, in figure 2, an "X" icon in the clipboard window, that upon selection closes the clipboard window.

8. With regard to claim 12, which teaches a computer usable medium including a program for displaying a clipboard (see MS figure 2), comprising: computer readable code for receiving a paste command, MSword teaches, in figure 2 and 4, receiving a paste command through an icon on the clipboard, through the Edit menu, or through typing CONTROL+V on the keypad. With regard to claim 12, which further teaches computer readable code for determining whether a plurality of objects are stored within the clipboard in response to the paste command, MSword teaches, in figures 2, 4, and 10, that in order for an item to be pasted it must be copied/cut from a document first,

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and upon a selection of more than one item to be copied/cut the clipboard is automatically displayed on the screen. With regard to claim 12, further teaching computer readable code for displaying a clipboard adjacent a display position indicator, if it is determined a plurality of objects are within the clipboard, MSword teaches, in figures 1 and 2 that upon selection of more than one item to be stored on a clipboard the clipboard is displayed to provide the user with a selectable array of pasteable items.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft, "Microsoft Word," hereinafter MSword in view of Foster et al., Patent Number: 5,404,442, hereinafter Foster.

11. With regard to claim 1, which teaches a method of previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 1, further teaching displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a preview

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(text representative of text copied to the clipboard element) of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before them at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination so as to allow the user to "see the object and therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

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12. With regard to claims 2 and 10, which teach receiving an icon preview instruction comprises determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period, MSword teaches, in MS figures 2 and 3, the preview being delayed by some predetermined time.

13. With regard to claims 3 and 11, which teach displaying the graphical image comprises displaying a reduced image of the graphical image, MSword teaches, in MS figures 2 and 9, upon positioning an indicator over an element in the clipboard, displaying a subset of the text copied to the clipboard. Foster further teaches, initiating selection of an item from the group of clipped items causing the user to be provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

14. With regard to claim 9, which teaches a computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: computer readable code for receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 9, further teaching computer readable code for displaying the graphical image associated with the icon in

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response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a textual preview of a clipboard item in response to a mouse over event.

MSword, however, doesn't specifically teach displaying a **graphical image** associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23). It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before him at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination so as to allow the user to "see the object and therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

Response to Arguments

Applicant's arguments, presented in the appeal brief of 10/16/2006, with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Status of action

The instant office action represents a **NON-FINAL** office action and therefore the Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this action is set to expire **THREE MONTHS** from the mailing date of this action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this non-final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DENNIS G. BONSHOCK whose telephone number is (571)272-4047. The examiner can normally be reached on Monday - Friday, 6:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

***/Donald Sparks/
Acting Director of TC 2100***

/Dennis G. Bonshock/
Examiner, Art Unit 2173
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